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CANADA

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| EXAMINER |
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TRUJILLO, JAMES K

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| ART UNIT | PAPER NUMBER |
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2116

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06/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/500,131

Applicant(s)

MADTER ET AL.

Examiner

James K. Trujillo

Art Unit

2116

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 May 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,2,4-10 and 12-20.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/James K. Trujillo/
Primary Examiner, AU 2116
Technology Center 2100

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments filed 22 May 2007 have been fully considered but they are not persuasive.

Applicant argues in substance that the cited art, alone or in combination, does not teach a verification step that is independent of the code content of flash memory. However, the feature of "a verification step that is independent of the code content of flash memory" is not recited in any claim other than claims 1, 2, 4-10 and 12-17. Further, claims 18-20 also does not exactly recite "a verification step that is independent of the code content of flash memory". Claims 18 and 20 only recite "the key value being independent of the contents of FLASH memory..." which is not the same as a "verification step that is independent of the code content of flash memory." In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., verification step that is independent of the code content of flash memory) are not recited in rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Even so, Mirov teaches a key value that is independent from the contents of the FLASH memory because the key value does not depend on the contents of the FLASH memory (the signature is calculated using a public key that is independent of contents of PROM 18, figure 2 and col. 4, lines 18-41). Therefore, Mirov teaches a key value being independent of the contents of FLASH memory.

Applicant argues in substance that the pending claims are directed to a security feature. The examiner does not disagree. However, because Mirov and Cooper teach the claimed invention, they are also directed to a security feature. Further, Applicant's argument that the claims are directed to a security feature is interpreted to be an intended use. In response to applicant's argument that the claims are directed toward a security feature, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. While there may be differences between the Applicant's structures in the specification, the claimed structures are met by the combination of the prior art and it capable of performing the intended use. Applicant argues that the motivation that the Examiner identified could not exist and that there would be not reason to add the teachings of Mirov to Cooper. However, in the Office Action the rejection point to Mirov being modified by Cooper not Cooper being modified by Mirov. Further, Mirov has features not taught by Cooper, that is why Mirov is relied upon. Cooper has feature that is not taught by Mirov, that is why Cooper is relied upon. Further the motivation to modify Mirov with Cooper is found in Cooper. Applicant is directed to col. 3, lines 18-26 for motivation that is found in Cooper. That is, modifying Mirov with the teaching of Cooper would provide the desired feature found in Cooper.

Applicant argues in substance that there is no apparent reason for the modification of Mirov by Cooper (see Applicant's remark page 10, beginning at the second paragraph). As addressed in the previous Office Action, the motivation is apparent in Cooper (see Cooper, col. 3, lines 18-26).

Applicant argues in substance that the identification of the AAPA is in error because the word "not" was inadvertently omitted from the rejection on page 7, line 16. The examiner would like to thank the Applicant for pointing out the obvious typographical error of the omission of the word "not" in the rejection of claim 4. The line should in fact read, "AAPA does not explicitly disclose..." instead of "AAPA does explicitly disclose...." This obvious typographical error should be obvious since claim 18 also uses the same grounds of rejection beginning on page 9 and states "AAPA does not explicitly disclose..." on page 9, line 20.